UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,303	05/08/2001	Atsushi Shibuya	P/1905-101	3103

7590 11/17/2004

Steven I Weisburd
Dickstein Shapiro Morin & Oshinsky LLP
1177 Avenue Of the Americas
41st Floor
New York, NY 10036

EXAMINER
LE, LANA N

ART UNIT	PAPER NUMBER
2685	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 19* is/are rejected.

7)☒ Claim(s) *17 and 18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>4, 5</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Specification

1.   Applicant is reminded of the proper language and format for an abstract of the

disclosure.

The abstract should be in narrative form and generally limited to a single

paragraph on a separate sheet within the range of 50 to 150 words. It is important that

the abstract not exceed 150 words in length since the space provided for the abstract

on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "the," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether

there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information

given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure

describes," etc.

- line 11, after "is also", "disclosed" is stated which in not proper abstract

language.

2.   The abstract of the disclosure is objected to because there is a minor typo in line

4, where after "predetermined", "work" should be "word". Correction is required. See

MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

        - for claim 19, the specification only specifies transmitting mail, it does not specify

the transmitting of the keyword table is done wirelessly or via wireline to transmit

keyword table. Appropriate correction is required.

Claim Objections

5.   Claims 1, 2 are objected to because of the following informalities:

        - claim 1, line 5, after "predetermined", only one of "word" or "keyword" should be

used.

        - claim 2, line 2, after "keyword is", only one of "inverted" or "displayed" should be

        used.

6.   Claims 16 and 18 are objected to under 37 CFR 1.75(c), as being of improper

dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form.

 Appropriate correction is required.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8.   Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by

Shin et al (US 6,269,260).

Regarding claim 1, Shin et al discloses a method of calling a function by keyword

detection in a portable communication terminal apparatus comprising the steps of:

registering a function provided for the portable communication terminal

apparatus in association with a predetermined word (col 3, line 64 - col 4, line ; figs. 3a-

3b), and when the registered keyword (character codes, i.e. the word "MAIL", that were

stored that represents a function; col 5, lines 42-45) is extracted from character data

displayed on a display screen (display 30, the subroutine of the character recognition

mode wherein the character data input is received from touch screen 40 to be displayed at 30 via CPU 10 at col 5, lines 44-45; col 3, lines 22-23 or character data input can be displayed from user input at key input unit 20, see col 3, lines 57-59) of the portable communication terminal apparatus (mobile telephone), calling and executing the function registered in the portable communication terminal apparatus in association with the extracted keyword (col 5, lines 42-45, i.e. calling the registered message read function that is associated with keyword "MAIL").

Regarding claim 2, Shin et al disclose a method according to claim 1, wherein the extracted keyword (character code) is inverted/displayed on portable phone (displayed via display 30 when user inputs characters; col 5, lines 11-18, lines 31-35, lines 54-60, lines 54-62).

Regarding claim 5, Shin et al discloses a method according to claim 1, wherein the function comprises a function of registering display character data following the extracted keyword (character codes inputted by user at key input unit 20 are displayed; col 3, lines 57-59; col 5, lines 42-45) in a built-in memory (function character storage 70; col 4, line 66 – col 5, line 3).

Regarding claim 6, Shin et al discloses a method according to claim 2, wherein the function comprises a function of registering display character data following the extracted keyword (character codes inputted by user at key input unit 20 are displayed; col 3, lines 57-59; col 5, lines 42-45) in a built-in memory (function character storage 70; col 4, line 66 – col 5, line 3).

Regarding claim 7, Shin et al disclose a method according to claim 1, wherein the function comprises a function of replacing the extracted keyword with another character (i.e. in the phone book function of Shin et al; col 3, lines 44-49, when the user inputs a pre-registered keyword, i.e. "phone directory" according to user's preference, in the character code storage area of figure 5, the keyword will enter the "phone book function" mode pre-registered in the function storage area; col 4, line 66 - col 5, line 3; and performs the function; col 5, lines 39-42; by replacing the keyword with another character which is a list of telephone numbers and their associated names; col 3, lines 45-50).

Regarding claim 8, Shin et al disclose a method according to claim 2, wherein the function comprises a function of replacing the extracted keyword with another character or an illustration (i.e. in the phone book function of Shin et al; col 3, lines 44-49, when the user inputs a pre-registered keyword, i.e. "phone directory" according to user's preference, in the character code storage area of figure 5, the keyword will enter the "phone book function" mode pre-registered in the function storage area; col 4, line 66 - col 5, line 3; and performs the function; col 5, lines 39-42; by replacing the keyword with another character which is a list of telephone numbers and their associated names; col 3, lines 45-50).

9.   Claims 9-12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (US 6,269,260) in view of Soini et al (US 6,445,932).

Regarding claim 9, Shin et al disclose a portable communication terminal apparatus (fig. 1 and hereafter; col 2, lines 41-43) comprising a CPU (CPU 10) controlling a function provided for the portable communication terminal apparatus (fig. 1), a storage section including a ROM (EEPROM within memory 60) used as an area in which a program (subroutine) for operating the CPU (10) is stored (col 3, lines 40-42) and a RAM (RAM within memory 60) used as an area for temporarily storing data during operation of the CPU (col 3, lines 25-28) and retaining data registered by the user (col 3, lines 28-29) a display section (30) used to display a character the display section under the control of the CPU (10),

a ten-key pad operating section (20) for allowing the user to perform key input operation (col 3, lines 57-59), and a button control section (40) used to transfer data key input by the user to the CPU (10) wherein an operation of executing the function are registered is stored in the RAM of the storage section (col 3, lines 26-28), and

the CPU (10) comprises means for looking up the keyword table, means for extracting the keyword from character data displayed on the display section and displaying the keyword in a recognizable form, and means for calling the function associated with the extracted keyword and controlling execution of the function when a function execution instruction is received from the button control section.

Shin et al do not explicitly disclose: the display section displays a graphic pattern and wherein a keyword table in which the function associated with a predetermined word (keyword) is stored in the RAM.

Soini et al disclose a display section for displaying graphic pattern (col 3, line 66-col 4, line 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the display of a radiotelephone to display graphics in the LCD of Shin et al in order to provide a graphics display so that the user can view image data as well as text as is well known in the integration of mobile phone with information technologies.

Even though Shin do not disclose: the keyword table in which the function associated with a predetermined word (keyword) is stored in the RAM but rather a separate memory 70 connected to the RAM within 60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the memory 60 and storage 70 into one memory since they both serve to store information.

Regarding claim 10, Shin et al and Soini et al disclose an apparatus according to claim 9, wherein Shin et al disclose the apparatus comprising the keyword table (char code storage area; see figure 5) stored in memory (70) which is connected with RAM of memory 60 which temporarily stores character codes. Shin et al does not explicitly disclose: the memory 70 is a volatile memory where it is configured such that a registered content can be changed or a content can be added. However, it is well known that since a user can program a character code word with a chosen function and store it, it is obvious that the user can alter this program based on the user's preference to reprogram a registered function by changing the registered character code with a new character code chosen by the user, i.e. a character code which might be easier to

remember; or to program and register another character code in addition to those

examples shown by adding to the memory content (figure 5; col 5, lines 42-45).

Regarding claim 11, Shin et al and Soini et al disclose the apparatus according to

claim 9, wherein Shin et al disclose the apparatus further comprising means for

inverting/displaying the extracted keyword as means for displaying a keyword in a

recognizable form (displayed via display 30 when user inputs characters; col 5, lines 11-

18; lines 31-35, lines 54-62).

Regarding claim 12, Shin et al disclose an apparatus according to claim 10,

wherein Shin et al disclose the apparatus further comprising means for

inverting/displaying the extracted keyword as means for displaying a keyword in a

recognizable form (displayed via display 30 when user inputs characters; col 5, lines 11-

18, lines 31-35, lines 54-60, lines 54-62).

Regarding claim 14, Shin et al and Soini et al disclose an apparatus according to

claim 9, wherein Shin et al disclose the apparatus wherein the CPU comprises a

function of registering displayed character data (register the character code) following

the extracted keyword in a built-in memory (char code storage area 70) upon reception

of a function execution instruction (commands for entering function mode) from the

button control section 40 (col 3, lines 40-42).

Regarding claim 15, Shin et al and Soini et al disclose an apparatus according to

claim 9, wherein Shin et al disclose the apparatus the CPU comprises a function of

replacing the extracted keyword (i.e. char code "phone directory" programmed by the

user) with another character (list of telephone numbers representing another character)

or an illustration and displaying the character or illustration upon reception of a function
execution instruction (commands for entering function mode associated with the
function character; col 3, lines 40-42) from the button control section 40 (i.e. in the
phone book function of Shin et al; col 3, lines 44-49, when the user inputs a pre-
registered keyword, i.e. "phone directory" according to user's preference, in the
character code storage area of figure 5, the keyword will enter the "phone book
function" mode pre-registered in the function storage area; col 4, line 66 - col 5, line 3;
and performs the function; col 5, lines 39-42; by replacing the keyword with another
character which is a list of telephone numbers and their associated names; col 3, lines
45-50).

Regarding claim 16, Shin et al and Soini et al disclose an apparatus according to
claim 15, wherein Shin et al disclose the CPU (10) comprises a function of replacing the
extracted keyword with another character or an illustration and displaying the character
or illustration upon reception of a function execution instruction from the button control
section (i.e. in the phone book function of Shin et al; col 3, lines 44-49, when the user
inputs a pre-registered keyword, i.e. "phone directory" according to user's preference, in
the character code storage area of figure 5, the keyword will enter the "phone book
function" mode pre-registered in the function storage area; col 4, line 66 - col 5, line 3;
and performs the function; col 5, lines 39-42; by replacing the keyword with another
character which is a list of telephone numbers and their associated names; col 3, lines
45-50).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which the subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin

et al (US 6,269,260) in view of Hoshino (US 6,285,891).

Regarding claim 3, Shin et al disclose a method according to claim 1, wherein

Shin et al disclose examples of a variety of phone functions (col 3, lines 42-45).

Shin et al don't further disclose:

the function comprises a function selected from a melody playback function,

sound effect function, voice function, display light blinking function, backlight blinking

function, and vibration motor control function or a combination thereof.

Hoshino discloses the function comprises a function selected via a single selection

button (col 14, lines 25-37) from a sound effect function (key confirming call volume),

voice function (received voice volume), and vibration motor control function (incoming

call vibration) or a combination thereof (col 5, lines 33-35).   It would have been obvious

to one of ordinary skill in the art at the time the invention was made for the user to

program a chosen character code with one of these functions, i.e. call ringer volume, for

the user to set the ringer volume level selected from a plurality of functions in order to

key in the character code and then set it after the sample ring sound is called out,

instead of having to manipulate through all the menu buttons to find the particular

function.

Shin et al and Hoshino don't specifically disclose:

a melody playback function, display light blinking function, backlight blinking function.

However, as Shin et al only lists some examples of common phone functions, see col 3,

lines 42-45, and a melody playback function, display light blinking function, backlight

blinking function are notoriously common and well known phone functions. It would

have been obvious to one of ordinary skill in the art at the time the invention was made

to include these common phone functions in the selected functions of Shin et al and

Hoshino in order to allow the phone's user to choose the preferred function he/she

wants from a more variety of phone functions to register a character code with.

Regarding claim 4, Shin et al disclose a method according to claim 2, wherein

Shin et al disclose examples of a plurality of phone functions (col 3, lines 42-45).

Shin et al don't further disclose:

the function comprises a function selected from a melody playback function,

sound effect function, voice function, display light blinking function, backlight blinking

function, and vibration motor control function or a combination thereof.

Hoshino et al disclose the function comprises a function selected via a single selection

button (col 14, lines 25-37) from a sound effect function (key confirming call volume),

voice function (received voice volume), and vibration motor control function (incoming

call vibration) or a combination thereof (col 5, lines 33-35).

Shin et al and Hoshino et al don't specifically disclose:

a melody playback function, display light blinking function, backlight blinking function.

However, as Shin et al only lists some examples of common phone functions, see col 3, lines 42-45, and a melody playback function, display light blinking function, backlight blinking function are notoriously well known phone functions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include these common phone functions in the selected functions of Shin et al in order to allow the phone's user to choose the function he/she wants to register a character code with.

12.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (US 6,269,260) in view of Soini et al (US 6,640,113) and further in view of Jahagirdar et al (US 6,304,763).

        Regarding claim 13, Shin et al and Soini et al disclose an apparatus according to claim 9, wherein Shin et al disclose the mobile telephone apparatus inherently comprises an output section (speaker in a dual tone multi frequency part not depicted) used to output an audio signal (col 2, lines 40-45).

Shin et al and Soini et al do not further disclose:

        a backlight used to illuminate the display section, a display light ON/OFF controlled by the CPU, and a vibration motor which is ON/OFF-controlled by the CPU to generate vibrations to be felt by a user.

        Jahagirdar et al disclose:

a backlight (522) used to illuminate the display section, a display light ON/OFF

(LED display) controlled by the CPU 504 (col 4, lines 36-41), and a vibration motor 511

which is ON/OFF-controlled by the CPU 504 to generate vibrations to be felt by a user

(fig. 5).

the CPU (controller 504; fig. 5) comprises means (inherent within controller 504)

for controlling one operation selected from melody playback, sound-effect operation,

voice outputting operation by the sound output section (116), blinking of the display

light, blinking of the backlight, control of the vibration motor 511 or a combination

thereof (controller to 511).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have a backlight and the controller controlling one operation selected from

voice, sound, etc. in order to have a control for controlling output of one of the functions

selected.

13.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et

al (US 6,269,260).

Regarding claim 19, Shin et al and Shim et al disclose an apparatus according to

claim 9, further comprising means for transmitting the keyword table (the user input

characters) stored in the storage section, and means for storing the keyword in the

storage section from a temporary buffer to the permanent memory 70 if the table is

transmitted via wireline, i.e. for the keyword table storage or if the phone has email or

text messaging capabilities to transmit via email the stored keyword table to send

wirelessly the special functions the user had programmed to share with a friend by

transmitting wirelessly to another phone.

Allowable Subject Matter

14.   Claims 17-18 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten to overcome the claim objection in independent form

including all of the limitations of the base claim and any intervening claims.

Regarding claim 17, Shin et al disclose and apparatus according to claim 15,

wherein Shin et al and the cited prior art fail to further disclose the CPU comprises a

function of replacing the character or illustration with the original keyword and display

the keyword upon reception of a function execution instruction from the button control

section.

Regarding claim 18, Shin et al disclose an apparatus according to claim 16,

wherein Shin et al and the cited prior art fail to further disclose the CPU comprises a

function of replacing the character or illustration with the original keyword and display

the keyword upon reception of a function execution instruction from the button control

section.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana N Le whose telephone number is (703) 308-5836. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lana Le

November 12, 2004